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10/091,172

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Juan I. Perez

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EXAMINER

SCHILLINGER, ANN M

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/091,172  
Filing Date: March 04, 2002  
Appellant(s): PEREZ ET AL.

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Joshua L. Cohen  
Glenn M. Massina  
For Appellant

**EXAMINER'S ANSWER**

Art Unit: 3774

This is in response to the second supplemental appeal brief filed 9/10/2008 appealing from the Office action mailed 1/12/2007. The previous Examiner's Answer dated 4/17/2008 has been vacated.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

A substantially correct copy of appealed claims 1-25 appears on pages 11-16 of the Appendix to the appellant's brief. The minor errors are as follows: claims 10, 11, and 23 are listed, but are not subject to the present Appeal.

**(8) Evidence Relied Upon**

6,090,136	MCDONALD ET AL.	7-2000
6,132,458	STAEHLE ET AL.	10-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 12-22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald et al. (6,090,136) in view of Staehle et al. (6,132,458). McDonald et al. discloses a device for delivering multiple self-expandable vascular stents (130) comprising a guidewire (110), a pusher (134) and a inferiorly loaded sheath (e.g. 126, 162) however McDonald et al. fails to disclose a loading capsule. Staehle et al. teaches a loading capsule (10) for releasably retaining a compressed stent. It would have been obvious to one of ordinary skill in the art to combine the teaching of a loading capsule, as taught by Staehle et al., to a device for delivering multiple self-expandable vascular stents as per McDonald et al., the motivation to combine being the stent within the capsule of Staehle et al. “would not be subjected to compression set due to compression for prolonged period of time” (col. 1, lines 10-15).

**(10) Response to Argument**

Regarding the Appellant's arguments that there is no reasonable basis to combine the teachings of McDonald et al. and Staehle et al., motivation has been provided which states that the stents within the capsule of Staehle et al. would not be subjected to long periods of compression. When combining McDonald et al. and Staehle et al., as described above, there is a reasonable expectation of success that the structure of McDonald et al. will not become stuck in the funnel structure of the Staehle et al. device. MPEP 716(C) states the following regarding a determination of inoperability: The arguments of counsel cannot take the place of evidence in the record. Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include inoperability of the prior art.

Further regarding claim 1, the Appellant contends that McDonald et al. and Staehle et al. do not teach or suggest a capsule configured to receive a subsequent treatment component. However, the pusher (20) of Staehle et al. is a removable element that can be re-inserted, therefore, the loading capsule of Staehle et al. is configured to allow for subsequent treatment components.

The Appellant further argues the stent of McDonald et al. may not work within the delivery device of Staehle et al. However, the Appellant has provided no evidence to show that the two devices may not work together, and it has been held that the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

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Regarding claim 18, the Appellant contends that neither of the cited references teaches or suggests a pusher configured to releasably receive each of the plurality of endovascular graft components. However, the claim does not specify that the pusher assembly acts on one component at a time. The cited pusher can receive the endovascular graft assembly as a whole, which meets the requirements of the claim language. When the two references are combined, the McDonald et al. reference provides grafts (130), pusher assembly (122), and sheath (126). The rod of McDonald et al. is removed to allow for the capsule of Staehle et al. to be attached to element 122, of above. Sheath (126) is configured to mate to the capsule by means of the pusher assembly, as the claim does not require that these two parts be directly connected to each other.

Regarding claim 22, the Appellant contends that there is no motivation for one skilled in the art to attach a loading capsule to a pre-loaded catheter. However, the claim language does not specify that the steps of the method are required to be done in the written order of the claim. The language addressing the “subsequent endovascular graft component,” is being interpreted as additional endovascular graft components, and not as an indicator of the order of the steps. Therefore, the steps of attaching the capsule; inserting a subsequent endovascular graft component; advancing the subsequent endovascular graft; and deploying the subsequent endovascular graft component would occur during the pre-loading of these stents when using the teachings of the cited references.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ann Schillinger/

Examiner, Art Unit 3774

/David J. Isabella/

Supervisory Patent Examiner, Art Unit 3774

/Thomas Barrett/

TQAS TC3700